

REMARKS

Upon entry of this paper, no claims have been amended, no claims have been canceled, and no claims have been added as new claims. Thus, claims 1-4 and 6-9 are presently pending in this application. No new matter has been added.

Claim Rejections under 35 U.S.C. §102

Claims 1-2

Claims 1-2 were rejected under 35 U.S.C. §102 as being anticipated by US Patent No. 6,296,661 to Davila (Davila '661). This anticipatory rejection is respectfully traversed in view of the following comments.

In accordance with the accompanying Rule 1.131 Affidavit, Applicants conceived of and reduced to practice the invention claimed in claims 1 and 2 prior to the filing date of Davila '661. More specifically, Davila '661 was filed on February 1, 2000. Applicants' Rule 1.131 indicates that the invention was reduced to practice prior to August 5, 1998. The accompanying Rule 1.131 Affidavit and corresponding exhibits show a radially deployable stent having a stent structure with an inner surface and an outer surface, and a stent covering comprising an inner cover of biocompatible material positioned adjacent said inner surface of said stent structure, and an outer cover of biocompatible material positioned adjacent said outer surface of said stent structure, wherein at least one of said biocompatible material of said inner cover and said biocompatible material of said outer cover has a predetermined thickness and has an average internodal distance (IND) of greater than 100 microns to reduce a deployment pressure necessary to expand the stent to less than 10 atmospheres.

Under 35 U.S.C. §102(e), a person shall be entitled to a patent unless "the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . ."

Because the effective date of Davila '661, February 1, 2000, is after the date of reduction to practice of the claimed invention by the Applicants, the Davila '661 reference does not qualify as prior art under 35 U.S.C. §102(e), or under any other subsection of 35 U.S.C. §102.

As such, Applicants respectfully submit that this rejection under 35 U.S.C. §102 is overcome. In light of the above comments, Applicants respectfully submit that the claims of the present invention are not anticipated by, and are therefore in condition for allowance over, the cited document.

Claim Rejections under 35 U.S.C. §103

Claims 1-4

Claims 1-4 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over US Patent No. 6,124,523 to Banas (Banas '523) in view of Davila '661. This rejection is respectfully traversed in view of the following comments.

Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time of invention. As previously indicated, Davila '661 does not qualify as prior art under 35 U.S.C. §102 because the claimed invention of independent claim 1 was conceived of and reduced to practice prior to the filing of the Davila '661 reference. To establish a case of obviousness, all claim limitations must be taught or suggested by the prior art.

The Banas '523 reference fails to teach or suggest the expanded PTFE having an IND of more than 100 microns, as stated in the Office Action at page 3, line 7-8. Because the effective date of Davila '661, February 1, 2000, is after the date of reduction

to practice of the claimed invention by the Applicants, the Davila '661 reference does not qualify as prior art. Therefore, the proposed combination cannot be made, and thus not all elements of the pending claims are taught or suggested.

As such, this rejection under 35 U.S.C. §103 must be withdrawn. Dependent claims 2-4 are also allowable based on their dependency on the aforementioned independent claim 1 in addition to their own claimed characteristics. Applicants further submit that all pending claims of the present invention are not obvious with respect to, and are therefore allowable over, the cited documents.

Claims 6-9

Claims 6-9 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Banas '523 in view of Davila '661, and in further view of US Patent No. 5,993,489 to Lewis (Lewis '489). This rejection is respectfully traversed in view of the following comments.

Claim 6 is also directed to the invention evidenced as having been reduced to practice by the accompanying Rule 1.131 Affidavit prior to August 5, 1998. As with the above-noted obviousness rejection, the present rejection relies upon Davila '661 to show various aspects of the covering on the stent having an IND of greater than 100 microns. Lewis '489 has been added to the combination to allegedly teach a radial thickness. However, Lewis '489 does not teach or suggest an IND of greater than 100 microns. Thus, because Davila '661 fails to qualify as prior art in light of the accompanying Rule 1.131 Affidavit, the present obviousness rejection fails to teach or suggest all elements of the claimed invention of claim 6. Therefore, Applicants respectfully submit that claim 6 is allowable over the cited documents.

Dependent claims 7-9 are also allowable based on their dependency on the aforementioned independent claim 6 in addition to their own claimed characteristics.

Applicants further submit that all pending claims of the present invention are not obvious with respect to, and are therefore allowable over, the cited documents.

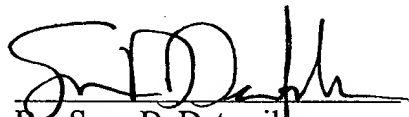
CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is now in condition for allowance. Applicants courteously solicit allowance of the claims in the form of a Notice of Allowance. Should there be any outstanding issues of patentability following the entry of this response, a telephone interview is respectfully requested to resolve such issues.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP



By: Sean D. Detweiler

Reg. No. 42,482

Attorney for Applicants

28 State Street
Boston, MA 02109-1784
Tel: (617) 227-7400
Fax: (617) 742-4214

Date: June 30, 2003